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PATENT
SP02-201

**NOTICE OF APPEAL FROM THE PRIMARY EXAMINER
TO THE BOARD OF APPEALS**

In re application of: Comte et al

Serial Number: 10/659785

Filed: 9/9/2003

For: CERAMMABLE MINERAL GLASS, GLASS-CERAMIC ARTICLES
AND PREPARATION THEREOF

Group Art Unit: 1755

Examiner: Karl E. Group

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby appeal(s) to the Board of Appeals from the decision dated May 3, 2005 of the Primary Examiner finally rejecting claim(s) 1-5, 12-17.

Corning Incorporated hereby authorizes to charge deposit account 03-3325 in the amount of \$500.00. Duplicate copy of this Notice is enclosed herewith.

Respectfully submitted,

Attorney for Assignee
Siwen Chen
Limited Recognition No. L0023
Corning Incorporated
SP-TI-3-1
Corning, NY 14831
(607) 248-1253

DATE: August 3, 2005

Date of Deposit: 8/3/05

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date indicated above with sufficient postage as first class mail in an envelope addressed to the: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

Signature

Jennifer M. Richtmyer

08/08/2005 EFL0RES 00000051 033325 10659785

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------|-------------|----------------------|---------------------|------------------|
| 10/659,785 | 09/09/2003 | Marie Comte | SP02-201 | 5590 |
| 22928 | 7590 | 05/03/2005 | EXAMINER | |
| CORNING INCORPORATED | | | GROUP, KARL E | |
| SP-TI-3-1 | | | ART UNIT | |
| CORNING, NY 14831 | | | PAPER NUMBER | |

1755

DATE MAILED: 05/03/2005

Received

MAY 6 2005

Patent Department

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED
MAY - 6 2005 ds
Final Rejection 7/3/05
Notice of Appeal 8/3/05
Statutory Bar 11/3/05



Office Action Summary

Application No.

10/659,785

Applicant(s)

COMTE ET AL

Examiner

Karl E. Group

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Election/Restrictions

1. The restriction between groups I and III is withdrawn in view of applicants' that Groups I and III are obvious over each other and are not patentably distinct.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5,11-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 12 stand rejected for claiming amounts of ZrO_2 that are not possible while maintaining the claimed ratio of $\text{TiO}_2/\text{ZrO}_2$ between 2.2 and 4.5. For example if the ZrO_2 content were 2.5 the amount of TiO_2 would have to be at a minimum 5.5 wt% (to maintain a ratio of 2.2) which is outside the claimed range. For compositions to have the claimed $\text{TiO}_2/\text{ZrO}_2$ the maximum amount of ZrO_2 would be 1.59 wt%. $3.5/1.59=2.2$. Applicants argue one of ordinary skill in the art can determine what compositions fall inside and outside the [claimed] limitations. This is not persuasive because amounts of ZrO_2 claimed 1.59 wt% to 2.5 wt% are not possible while maintaining the claimed $\text{TiO}_2/\text{ZrO}_2$ ratio. It is not clear whether the claimed $\text{TiO}_2/\text{ZrO}_2$ ratio is a required limitation of the claim if amounts of ZrO_2 are being claimed that are not possible to maintain the ratio.

Conclusion

4. The rejections over the prior art references are withdrawn in view of applicants' argument that the prior art of record fails to teach the claimed ratio of $\text{TiO}_2/\text{ZrO}_2$ between 2.2 and 4.5 and the unexpected results achieved by maintaining this ratio.
5. Should the above $\text{TiO}_2/\text{ZrO}_2$ ratio be removed from the claims, in response to the above 112 rejection, the prior art rejections may be reinstated and the finality of the rejection will be maintained.
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl E. Group whose telephone number is 571-272-1368. The examiner can normally be reached on M-F (6:30-4:00) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karl E Group
Primary Examiner
Art Unit 1755

Keg
5-2-05